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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

SALVATORE, LYNDIA

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 04 28 2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/709,743

Applicant(s)

ENKLER ET AL.

Examiner

Lynda M Salvatore

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12/27/02.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Response to Amendment*

1. Applicant's amendment, Paper No. 13, has been entered as requested. Claims 1, 15, 16, and 20 have been amended accordingly.

2. Applicant's amendments to claims 15 and 16 are sufficient to obviate the 112 2<sup>nd</sup> paragraph indefinite rejections as set forth in section 4 of the last Office Action. As such, this rejection is withdrawn.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-19 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Applicant has amended claim 1 to include the limitation of "adapted for exposure to an engine compartment thermal environment" and "adapted for planar contact with the surface". It is the position of the Examiner that these "adapted to" limitations constitute new matter since they are not supported by the Applicants specification. The specification is silent with regard to the first covering layer having the ability to withstand the thermal environment of an engine compartment and only discloses a layer comprising high-temperature resistant fibrous structures. The specification fails to teach how these high temperature resistant fibrous structures are "adapted " or processed to withstand the

Art Unit: 1771

thermal environment of an engine compartment. With regard to the second covering layer "adapted for planar contact with the surface", the specification fails to in what way the second covering layer is "adapted for planar contact with the surface".

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claim 1 is indefinite because of the phrase "adapted to". It is unclear to the Examiner how the first covering layer is "adapted to" for exposure to an engine compartment and how the second covering layer is "adapted to" for planar contact.

***Claim Rejections - 35 USC § 102/103***

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claims 1,13,17-22 and 24 stand rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Alts, US 6,145,617. Applicant's amendment to claim 1 is not found sufficient to overcome this rejection, because the prior art of references teaches the limitations set forth in claim 1. Applicant has amended claim 1 to further include the limitation of a first covering layer "adapted for exposure to an engine compartment thermal environment" and a second covering layer in planar contact with the soundproofing layer "and adapted for planar contact with the surface". These limitations are not given patentable weight since it has been held that the recitation that an element is "adapted to" perform a

Art Unit: 1771

function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ

***Claim Rejections - 35 USC § 103***

10. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

11. Claims 2,3,4-12,14 and 23 stand rejected under 35 USC 103(a) as being unpatentable over Alts, US 6,145,617 because the 102(e)/103(e) rejection stands and new arguments have been presented.

12. Claims 15-17 are rejected under 35 USC 103(a) as being unpatentable over Alts, US 6,145,617.

With regard to claims 15 and 16, Alts does not specifically teach the new limitation of a pattern of convex bulges formed as grid, however, it would have been obvious to one having ordinary skill in the art at the time the was made to form convex bulges, since such a modification would have involved a mere change in the shape of the lining. A change in shape is generally recognized as being within the level of ordinary skill in the art. *In re Daily*, 149 USPQ 47.

With regard to the orientation of the metal foil, recited in claim 17 and depicted in figure 9 of the Alts reference, the Examiner acknowledges that the placement of the metal layer is not exposed to the engine compartment, however, it would have been obvious to one having ordinary skill in the art at the time the invention was made to arrange the metal layer such that it is in

Art Unit: 1771

planar contact with an outer covering layer. It has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70

### ***Response to Arguments***

13. In response to the Applicant's argument that the Alts reference fails to teach the specific substrate layering orientation and materials, the Examiner maintains that the Alts teaches the combination of a soft-elastic open-pored layer with a microporous fiber layer or fiber/foam composite layer arranged thereover to obtain sound absorption/insulation and heat insulation (Column 2, lines 43-50). One embodiment of the invention as shown in figure 10, may be used the engine compartment of a motor vehicle. Figure 10 shows a composite having on the motor face side, a oil and water protective fleece connected to a microporous stiffening layer, followed by a spring layer (Column 6, lines 10-15). The assembly package of the invention may be adhered to the areal vehicle part or as shown in figure 10, using a carrier layer to provide added stability (Column 6, lines 25-27 and 35-37). The microporous stiffening layer material disclosed by Alts varies between embodiments. In figure 10 the microporous-stiffening layer consists of highly pressed fiber material (Column 6, lines 13-15), however, it may also consist of an open-pored fiber of a fiber/foam composite (Columns 3 and 4, lines 65-67 and line 1 respectively). The spring layer may consist of foam or a duroplastic mixed fiber fleece, thermomoulded foam, or a PU molded foam having an approximate thickness of 15mm (Column 6, lines 21-35). The carrier layer is described as consisting of highly pressed fiber material and is also shown in figure 8 (Column 5, lines 6-8). Alts also illustrates in figure 9, the addition of an aluminum foil layer that is adhered to the porous spring layer for better sound insulation (Column 5, lines 40-

Art Unit: 1771

50). All the layers of the composite taught by Alts may be connected to one another mechanically (stitched) or by adhesive (Column 2, lines 29-32).

With regard to the Applicant's argument of the presence of an "air layer" in the Alts reference and that claim 1 precludes such a layer, the Examiner asserts that the open claim language of "comprising" recited in claim 1 does not preclude an air layer.

With regard to the Applicant's arguments that the duroplastic foam layer of Alts would not have the claimed long-term thermal loadability, the Examiner maintains that the spring layer may consist of foam or a duroplastic mixed fiber fleece, thermomoulded foam, or a PU molded foam having an approximate thickness of 15mm. The Applicant argues that based on the thickness and density taught by Alts, the spring layer would not inherently possess the long-term thermal loadability as claimed by the Applicant. The Applicant further argues that by contrast the density and thickness duroplastic foam layer of the instant invention is such that the thermal characteristics would be different from that of the spring layer taught by Alts. In response, the Examiner asserts that that the Applicant has not claimed any specific thickness or density ranges. If thermal load is indeed a function of thickness and density, then Applicant should claim so. Without such limitations, the Examiner maintains that is reasonable to presume that the thermal loadability property recited in claim 1 is inherent to the Alts invention. Support for said presumption is found in the use of like materials (i.e., fiber and foam materials) and the use of like processes (heat and sound insulation), which would result in the claimed property. The burden is upon the Applicant to prove otherwise. *In re Fitzgerald* 205 USPQ 495

Art Unit: 1771

Alternatively, the presently claimed property of long-term thermal loadability at 200°C of three weeks would obviously have been present once the Alts product is provided. *In re Best*, 195 USPQ at 433

13. With regard to the Applicant's arguments of claims 2,3, 4-12, 14 and 23 based on the relating 102/103 arguments above, said arguments are not found to be persuasive because the 102/103 rejection stands and no new arguments have been presented.



Art Unit: 1771

*Conclusion*

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynda M Salvatore whose telephone number is 703-305-4070. The examiner can normally be reached on M-F.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 703-308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

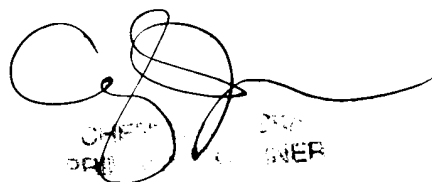
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Application/Control Number: 09/709,743

Page 9

Art Unit: 1771

Is   
March 10, 2003

  
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